



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Venegas, Jr.

Serial No.: 09/597,318

Group No.: 3635

Filed: June 19, 2000

Examiner: W. Yip

For: STANCHION SLEEVE AND METHOD OF USING SAME

**APPELLANT'S BRIEF UNDER 37 CFR §1.192**

Mail Stop Appeal Brief  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**I. Real Party in Interest**

The real party and interest in this case is Frank Venegas, Jr., Applicant and Appellant.

**II. Related Appeals and Interferences**

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**III. Status of Claims**

The present application was filed with 2 claims. Claims 3-6 were added by amendment in October 2001; claim 7 was added by amendment in September 2002. Claims 5 and 7 were canceled by amendment in November 2003. Claims 1-4 and 6 were canceled, and claims 8-15 were added by amendment in September 2004. Claim 15 was canceled by amendment in February 2005. Claims 13-14 are being canceled by an after-final amendment attached hereto. Claims 8-12 are pending, rejected and under appeal. Claim 8 is the sole independent claim.

**IV. Status of Amendments Filed Subsequent  
Final Rejection**

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An after-final amendment is attached hereto, wherein claim 8 has been amended, and claims 13-14 have been canceled. These amendments are reflected in the claims in the Appendix A, Claims on Appeal section of this Brief.

## V. Summary of Claimed Subject Matter

Independent claim 8 resides in a cover 14 for a post extending upwardly from a ground surface, the cover consisting of: an elongated, generally cylindrical plastic sleeve having an open lower end 24 and a closed, hemispherically shaped upper end 26. The sleeve has a consistent wall thickness including the hemispherically shaped upper end, and an interior diameter in the range of 3 to 8 inches. (Specification, page 4, lines 13-14; page 6, line 15 to page 8, line 14; Figures 5-9)

## VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

1. The rejection of claims 8-9 and 12 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,319,328 to Finger et al.
2. The rejection of claims 8 and 13 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,450,345 to Kervin.
3. The rejection of claims 8 and 11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,516,756 to Beatty in view of U.S. Patent No. 5,299,883 to Arth, Jr.

## VII. Argument

### A. The Rejection of Claims 8-12, Wherein Claims 9-12 Stand/Fall With Claim 8.

Claim 8 is directed to a cover for a post ... *consisting of*:

“an elongated, generally cylindrical plastic sleeve having an open lower end and a closed, hemispherically shaped upper end; and  
the sleeve having a consistent wall thickness including the hemispherically shaped upper end, and an interior diameter in the range of 3 to 8 inches.”

The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other

than those recited except for impurities ordinarily associated therewith.").

Claims 8 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,319,328 to Finger et al. However, among other potential differences, Finger does not disclose a hemispherically shaped upper end. Rather, the top portion shown in Figures 6 and 13 is conical. "In the event that the utility pole 31 (FIG. 3) has a conical cut or step 32 we provide a corresponding conical configuration 33 for the protective cap 34 shown in FIG. 6." (Finger, 2:59-62) Anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Systems, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation requires the presence of all elements of a claimed invention as arranged in the claim, such that a disclosure "that 'almost' meets that standard does not 'anticipate'." Connell v. Sears, Roebuck Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). Since a cone is not a hemisphere, anticipation has not been established.

Claim 8 also stands rejected under 35 U.S.C. §103(a) over U.S. Patent No. 2,450,345 to Kervin. However, Kervin does not disclose a hemispherically shaped upper end (it is also conical), and Kervin teaches other essential components, namely, engaging members 18. Rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Even if it were obvious to modify Kervin according to the Examiner's prescription, it would not be obvious to remove the engaging members 18 as they are "essential." (Kervin, 2:10-15) Accordingly, *prima facie* obviousness has not been established.

Claims 8 further stands rejected under 35 U.S.C. §103(a) over U.S. Patent No. 4,516,756 to Beatty in view of U.S. Patent No. 5,299,883 to Arth, Jr. The Examiner acknowledges that Beatty does not disclose a hemispherical top, but again argues that it would have been obvious to combine Beatty with Arth, Jr. "as an obvious matter of design choice." However, given that Beatty is intended to utilize a top which is conformal to flat cuts made at the top of a post, there is nothing obvious about the conversion of a flat top to a hemispherical top, since there are no hemispherically-topped posts disclosed in the '756 patent. Moreover, even if the Examiner's proposed combination were legitimate,

the combination includes other essential components, namely, the strap 12 and interlocking inner flared lip of Arth, Jr. Accordingly, *prima facie* obviousness has not been established.

### Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellant seeks the Board's concurrence at this time.

Respectfully submitted,

By: \_\_\_\_\_

John G. Posa

Reg. No. 37,424

Gifford, Krass, Groh, Sprinkle,

Anderson & Citkowski, P.C.

PO Box 7021

Troy, MI 48007-7021

Tel. (734) 913-9300 Fax (734) 913-6007

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**APPENDIX A**

**CLAIMS ON APPEAL**

8. A cover for a post extending upwardly from a ground surface, the cover consisting of:  
an elongated, generally cylindrical plastic sleeve having an open lower end and a closed, hemispherically shaped upper end; and  
the sleeve having a consistent wall thickness including the hemispherically shaped upper end, and an interior diameter in the range of 3 to 8 inches.
9. The cover of claim 8, wherein the plastic is polyethylene.
10. The cover of claim 8, wherein the plastic is polycarbonite.
11. The cover of claim 8, the sleeve further including an agent to provide a durable coloring throughout.
12. The cover of claim 8, the sleeve further including an additive to resist ultraviolet deterioration.

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**APPENDIX B**

**EVIDENCE**

None.

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**APPENDIX C**

**RELATED PROCEEDINGS**

None.